



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,429	01/06/2004	Chern Hway Seet	246121US-8 CONT	3201

22850 7590 07/12/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,429

Applicant(s)

SEET ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-20, 29, 30, 32 and 33 is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 21-28, 31 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-2005 & 3-2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 January 2006 has been entered.

Declarations Under 37 CFR 1.131

2. The declaration filed on 17 January 2006 under 37 CFR 1.131 is sufficient to overcome the McCurdy et al. reference. Ho (US005909207A), who is also one of the instant inventors, teaches every significant feature of the reference, save one. That missing feature (claim 1) is the insertion of an ad into the content. The email message written on 7 June 2000, submitted as part of evidence exhibit A, demonstrated that the instant inventors also conceived that feature before the effective date of the reference, 30 June 2000.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-10, 21-28 and 31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for other limitations of the claims, does not reasonably provide enablement for variable flipping speed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.
5. The instant specification does not disclose how to achieve variable flipping speed. However, the instant spec. incorporates Ho (US005909207A) by reference, and Ho discloses a browsing device by which to achieve variable flipping speed. While this satisfies the written description requirement, the examiner judges the mere incorporation by

Art Unit: 3622

reference would not enable one of ordinary skill in the art to link Ho to the claimed limitation. Hence the enablement requirement is not satisfied.

6. This rejection can be overcome by adding a sentence to the instant specification, said sentence referring explicitly to the browsing device taught by Ho as a means by which to achieve variable flipping speed. The examiner suggests in particular that the following sentence be added to the end of the first full para. on spec. p. 8, which currently ends with *flip-browsing controller described in U.S. Patent No. 5,909,207*). Before the right parenthesis add a period to end the existing sentence, and then add, "This flip-browsing controller allows the user to achieve a variable flipping speed."
7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1, 3-10, 21-28 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At the third line from the bottom of claim 1, "a number of the at least two pages" is indefinite.
9. This rejection can be overcome by amending the subject phrase to – the number of the at least two moving pages --.

Claim Rejections - 35 USC § 102 and 35 USC § 103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3622

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Ho (US005909207A). Ho teaches (col. 17 lines 25-44) a method for displaying information in an electronic book, comprising steps of: jumping to a selected page (e.g., page **607**) in the electronic book; and displaying a thickness image of pages skipped (*thick page 604*) moving across an image of the electronic book from at least one of right-to-left and left-to-right, wherein said thickness image of pages skipped is proportional to a number of pages skipped in said jumping step (Fig. 6B).
13. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being obvious over Ho (US005909207A) in view of the admitted prior art. Ho does not teach selecting and displaying a page with a hyperlink. Applicant admits as prior art (para. [0006]) selecting and displaying a page with a hyperlink. Because it is admitted as prior art that hyperlinks are common (para. [0005]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the admitted prior art to the teachings of Ho.

Suggestion of Allowable Subject Matter

14. Claims 11-20, 29, 30, 32 and 33 are allowable over the prior art made of record.
15. Claims 1, 3-10, 21-28 and 31 would be allowable over the prior art made of record if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action.
16. Allowance is further dependent on the successful completion of "template" searches in each the US patent, foreign patent and non-patent literature, and successful vetting at an allowance conference.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal*

Art Unit: 3622

fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

18. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

29 May 2006


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622